

ESTTA Tracking number: **ESTTA250264**

Filing date: **11/20/2008**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91182173
Party	Defendant FF Acquisition, L.L.C.
Correspondence Address	Scott W. Johnston Merchant & Gould P.C. 80 South Eighth Street, Suite 3200 Minneapolis, MN 55402-2215 UNITED STATES
Submission	Reply in Support of Motion
Filer's Name	Heather Kliebenstein
Filer's e-mail	hkliebenstein@merchantgould.com, aries@merchantgould.com, dockmpls@merchantgould.com
Signature	/Heather Kliebenstein/
Date	11/20/2008
Attachments	2008 11 20 Summary Judgment Reply.pdf (14 pages)(125987 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Odom's Tennessee Pride Sausage, Inc.,)	
)	Opposition No. 91182173
Opposer,)	
)	Mark: Boy Design
v.)	
)	Serial No.: 77/148,503
FF Acquisition, L.L.C.,)	
)	Filing Date: April 4, 2007
Applicant.)	
)	Published: October 2, 2007

APPLICANT'S REPLY MEMORANDUM IN SUPPORT OF ITS
MOTION FOR SUMMARY JUDGMENT

This case is ripe for summary adjudication because Opposer Odom's Tennessee Pride Sausage, Inc.'s ("Odom's") opposition brief fails to set forth any disputed material facts or show any facts that deserve adjudication at trial. Odom's statements regarding confusion are premised on legal arguments relating to undisputed facts or irrelevant facts. There are many facts the parties do not dispute that demonstrate no likelihood of confusion exists:

- The parties' marks are as follows:



- Application Serial No. 77/148,503 is for retail grocery store services and Odom's registrations are for sausages, other meat products and breakfast sandwiches;
- There is no market interface between the parties;
- There are no known instances of confusion between Application Serial No. 77/148,503 and Odom's marks;

- Applicant FF Acquisition, L.L.C. owns Registration No. 1,222,958, which is an incontestable registration dating back to 1983.
- Odom's has never opposed or objected to any prior mark owned by FF, including Registration No. 1,222,958 before and after renewal in 2003; and
- There is no confusion between FF's Registration No. 1,222,958 and Odom's design marks.

In view of these undisputed facts, all relevant DuPont factors indicate confusion is unlikely, particularly in view of the differences between the marks and diluted nature of boy designs on food products. Summary judgment should be entered in Applicant FF Acquisition, L.L.C.'s ("FF") favor.

Summary judgment precluding Odom's from opposing Application Serial No. 77/148,503 ("503 Application") is also appropriate because Odom's failed to produce any facts that show FF's prior registrations are not similar to the '503 Application. Odom's contends that FF's prior registrations that were canceled in 2003 cannot be used to support FF's claim of laches. These arguments misapply the legal standard and fail to recognize that at least one prior registration is currently subsisting. Odom's opposition fails to create a genuine issue of *material* disputed fact to allow Odom's claim to survive summary judgment on the Morehouse defense.

I. The Undisputed Facts Demonstrate No Likelihood of Confusion Exists Between Odom's Design Marks and the '503 Application.

A. Opposer has not Met its Burden of Proof to Demonstrate Confusion is Likely.

FF recognizes the burden is on FF to demonstrate summary judgment is appropriate as no disputed issue of material fact exists. Celotex Corp. v. Catrett, 477 U.S. 317 (1986). However, once FF has met this test, the burden shifts to Odom to demonstrate its claim of a likelihood of confusion. Spin Physics, Inc. v. Matsushita Electric Indus. Co., Ltd., 168 U.S.P.Q. (BNA) 605,

607 (TTAB 1970) (A party opposing summary judgment must “come forward with countervailing evidence establishing a need for trial”). The burden to prove confusion is Odom’s. Genesco Inc. v. Martz, 66 U.S.P.Q.2d (BNA) 1260, 1267 (TTAB 2003). Here, FF has shown the record is devoid of any evidence, disputed or otherwise, that shows the ‘503 Application is confusingly similar to Odom’s Pilgrim Boy Design. Odom’s never sought discovery from FF and therefore lacks the evidence to prove its case. (Decl. of Heather J. Kliebenstein in Supp. of Reply Mem. ¶ 2.) FF’s motion for summary judgment regarding a likelihood of confusion should be granted.

B. The Fact that Odom’s Design Marks and FF’s Design Mark are Visually Distinct, Regardless of Which Mark is Viewed, is Dispositive of all DuPont Factors.

Odom’s opposition contends that FF’s summary judgment motion is incomplete as it does not address all thirteen (13) factors set forth in the DuPont case. (Opp. Br. at 15.) However, not every DuPont factor must be considered by the Board. Han Beauty, Inc. v. Albert-Culver Co., 236 F.3d 1333, 1336, 57 U.S.P.Q.2d (BNA) 1577, 1559 (Fed. Cir. 2001) (“While it must consider each factor for which it has evidence, the board may focus its analysis on dispositive factors, such as similarity of the marks and relatedness of goods.”) Some may be dispositive by themselves, such as strength of the mark asserted and similarity of the marks. Id. A comparison of all of Odom’s marks and FF’s mark shows confusion is unlikely as the marks are not similar. Whether classified as a pilgrim or farmer, none of Odom’s marks are substantially similar to FF’s mark.¹

¹ Odom’s argues that consumers are likely to associate FF’s mark and Odom’s mark with a common source. This statement lacks legal citation, evidence of a famous common source, or even that the same consumers view both Odom’s and FF’s design marks. As it is Odom’s burden to demonstrate confusion, it is Odom’s that must prove these issues.

C. Odom's Admission that there is No Evidence of Actual Market Interface of the Parties or Actual Confusion Supports the Conclusion that Confusion Will Never Exist.

In the factual background, Odom's admits that there is no market interface between the parties. (Opp. Br. at 21.) Odom's also admits that it was unaware of FF's Farmer Boy Design prior to publication of the '503 Application. (Opp. Br. at 9-10.) Odom's also claimed it had no personal knowledge of any actual use of the mark depicted in Trademark Registration No. 1,222,958 ("958 Registration"), the predecessor to the '503 Application. Odom's then argues that confusion is still likely because FF has only used the '503 Application since 2007. (Opp. Br. at 21.)

Odom's argument ignores two important facts relating to whether confusion is likely. First, FF has used the '958, coupled with its incontestable status, the validity of the mark and registration, FF's ownership of the mark and F's exclusive right to use the ark in interstate commerce for the recited services. The '958 Registration is substantially similar to the design in the '503 Application. Continued registration of this mark since 1983 is conclusive evidence of incontestability and use in commerce. 15 U.S.C. § 1115(b). Accordingly, Odom's argument that FF has only used its Farmer Boy Design since 2007 is wrong.

Second, Odom's ignores the fact that the Trademark Office Examining Attorneys did not believe confusion was likely. None of Odom's designs were cited during prosecution of the '503 Application or the '958 Registration. Odom's design marks have been registered since 1970 for various food products. (App. Mem. In Supp. of its Mt. for Summ. Judgment. at 5.) FF filed the '503 Application on April 9, 2007. (*Id.*) This application proceeded to the Principal Register for publication on September 12, 2007, without any rejection from the Examining Attorney under §

2(d). (Id.) The Examining Attorney did not find any likelihood of confusion between the Farmer Boy Design and any other federally registered mark. Confusion is unlikely.

D. There is No Evidence on Record that the Channels of Trade Overlap or that Consumers View Grocery Store Services and Food Products as Identical or Related.

Odom's contends that both parties' products and services are offered through identical channels of trade and that the services and goods are closely related. Even assuming that the channels of trade are similar, there is still no evidence of confusion in the record. Odom's argument that the goods and services are similar or related is contradicted by Odom's other arguments. In its brief, Odom's tries to escape application of the Morehouse defense by claiming "bacon," "margarine," and "bread" are "much broader" than "retail grocery store services." (Opp. Br. at 14.) Odom's also admits there is no market interface between the parties and their goods and services. (Opp. Br. at 9-10.) If the marks were used in connection with related goods, the record would likely contain at least some evidence of their overlap. There is none.

E. FF's Evidence of Registration of Similar Boy Designs Demonstrates Odom's Design Marks are Weak.

Despite Odom's objections, the volume of third-party registrations for designs similar to the Farmer Boy Design and Pilgrim Boy Design shows that others have registered and used such designs in connection with food products and grocery store services. The multiple third-party registrations demonstrate the food industry uses such designs to brand food products and related services and that consumers are accustomed to seeing such designs by a multitude of food related businesses.²

² To the extent the Board finds this chart of registrations inadmissible, attached hereto as Exhibit 1 are copies of registrations as printed from the United States Patent and Trademark Office.

Odom's argues that little weight should be given to the evidence of third party registrations of marks incorporating designs similar to the Farmer Boy Design and Pilgrim Boy Design. (Opp. Br. at 16-17.) This argument is misplaced. While third party registrations do not show "use" per se, third party registrations are admissible to demonstrate how a mark is used in ordinary parlance. Institut Nat'l Des Appellations D'Origine v. Vintners Int'l Co., 958 F.2d 1574, 1582, 22 U.S.P.Q.2d (BNA) 1190, 1196 (Fed. Cir. 1992). When third party registrations are used to show a mark is descriptive, it is irrelevant whether the marks are in current use. See Spraying Sys. Co. v. Delevan, Inc., 762 F.Supp. 772, 778, 19 U.S.P.Q.2d (BNA) 1121, 1125 (N.D. Ill. 1991). In addition, the registrations show that the PTO, by registering a multitude of marks with such a common design, believes that the identical portions of the design marks are weak and not likely to cause confusion. J. Thomas McCarthy, McCarthy on Trademark and Unfair Competition § 11:90 (4th Ed. 1996). FF's evidence demonstrates that those in the food industry, consumers of food products, and the PTO all see designs similar to the Pilgrim Boy Design and Farmer Boy Design as weak and descriptive.

F. There is no Evidence on Record that Odom's Design Mark is Famous or Strong.

Much of Odom's opposition brief is focused on the alleged fame of their design mark. (Opp. Br. at 3-7.) However, Odom's claims fail to show their mark is famous and therefore entitled to strong protection. Establishing a mark is famous requires evidence of extensive use, advertising and sales and consumer recognition of the same. Christian Broad. Network v. Abs-Cbn Int'l, 84 U.S.P.Q.2d (BNA) 1560, 1567 (TTAB 2007) (finding mark entitled to broad scope of protection based on evidence of extensive use, advertising, sales and consumer recognition).

These registrations are complete electronic equivalents and are therefore sufficient to make these third-party registrations of record. Apogee Learning v. Apogee, Inc., 47 U.S.P.Q.2d (BNA) 1368 (TTAB 1998).

Noticeably missing from their opposition papers is any accounting regarding marketing expenses or sales of their products. Nor is there any evidence that a substantial percentage of consumers nationwide actually recognize Odom's marks. There is no evidence of record to show that Odom's design mark is famous nationwide.

Odom's evidence of fame fails to create an existence of *material* disputed facts. FF Acquisition does not dispute for the purposes of this summary judgment motion that Odom's undertook the activities it claims demonstrate fame. FF Acquisition does dispute, however, the legal import of these activities. There is no evidence of sales. There is no evidence of dollars expended on advertising. There is no evidence of consumer awareness. The opposite conclusion can be drawn from this evidence—the mark is not famous and there is no evidence to support a claim of fame. The evidence, even if accepted as true, fails to legally demonstrate the Pilgrim Boy Design is strong and entitled to a broad scope of protection. Therefore, given the vast differences between the marks, FF's incontestable registration for a nearly identical mark, the lack of actual confusion, the number and nature of similar third party marks, the fact that Odom's never objected to any of FF's prior registrations or use, and the differences between FF's services and Odom's goods, there is no likelihood of confusion.

II. The Undisputed Facts Show Odom's is Precluded from Opposing the '503 Application because Odom's Never Objected to FF's Many Farmer Boy Designs and Registrations.

The Morehouse defense prevents those not diligent in enforcing their trademark rights from precluding a good faith user from using a mark it has used for years. Here, Odom's arguments fail to create any genuine issue of material fact that FF has in fact used and registered at least one of its Farmer Boy Designs for many years. A visual comparison of the marks demonstrates they are substantially similar. Odom's also admits, by claiming ignorance of these

marks, that Odom's never objected to FF's use or registrations of any of these designs. The remainder of Odom's arguments are unsubstantiated, irrelevant, and fail to create a genuine dispute of material fact.

A. FF Has Used Substantially Similar Versions of its Farmer Boy Design Since 1977 on Substantially Similar Goods and Services.

FF does not dispute that the exact mark depicted in the '503 Application has only been used in commerce since March 28, 2007. However, Odom's has used one or more substantially similar versions of its Farmer Boy Design since 1977. Registration Nos. 1,222,761, 1,222,761, and 1,222,795 were registered in 1983. These marks were used continuously until 2003. The design depicted in the '958 Registration was registered in 1983 and renewed in 2003. While the design changed slightly during renewal, the Patent and Trademark Office ultimately found there was no material difference between these designs. The '958 Registration continues to be used in commerce today. (See Decl. of Susan Mayo in Supp. of FF Acquisition, L.L.C.'s Motion for Summary Judgment ¶ 3.) The '958 Registration is also incontestable, and therefore conclusive evidence of FF's ownership of the mark, registration of the mark, the validity of the registration and of FF's exclusive right to use the mark in interstate commerce for supermarket services. 15 U.S.C. § 1115(b).

These registrations are all substantially identical to the '503 Application. A comparison of all four prior registrations with the '503 Application is listed below:



(Decl. of Heather J. Kliebenstein in Supp. of App.'s Mot. For Summ. Judgment Exs. A-E.) All involve nearly the same boy design above the torso. Two prior registrations, the '761 and '795 registrations, include legs. According to Odom's arguments, these registrations all involve the same type of goods: food products and grocery store services. (See Odom's Br. at 7 and Kliebenstein Decl. Exs. A-E.)³

B. Odom's Never Sought to Oppose or Cancel these Registrations.

Odom's never opposed or sought to cancel any of these registrations. Odom's admits it has never done so; in fact, it admits that it was unaware of FF's design marks until the '503 Application published for opposition. (Opp. Br. at 9-10.) Yet as a matter of law, Odom's had constructive notice of these rights when the mark registered. 15 U.S.C. § 1072. FF has no responsibility to notify Odom's of its trademark usage throughout the United States.

Odom's incorrectly argues the Morehouse defense is inapplicable because the '958 Registration was slightly modified in 2003 and the '760, '761 and '795 registrations were canceled in 2003. There is no authority for this position. In fact, such an argument contradicts the established law with respect to the Morehouse defense, which permits application where the prior mark and the newly opposed mark are substantially similar. (App. Mem. In Supp. of its Mt. for Summ. Judgment at p. 10.) In addition, Odom's fails to explain why Odom's never sought to cancel these registrations while they were in use in commerce; namely from 1965 to 2003. Odom's also fails to explain why it never attempted to cancel the '958 Registration before or after its slight modification in 2003.

³ Odom's contends that bacon, margarine and bread are not similar to grocery store services. However, Odom's directly contradicts itself by previously claiming in its brief that its own food products, sold in grocery stores, are similar to grocery store services. (Odom's Br. at 7-8.)

C. The Addition of a Torso and Legs to the ‘958 Registration Does not Render the Morehouse Defense Inapplicable.

Odom’s also argues the ‘958 Registration is not the legal equivalent of the ‘503 Application because the addition of legs and a torso to the ‘958 Registration constitutes a material difference.⁴ Surprisingly, Odom’s bases its argument on a comparison of the ‘958 Registration and ‘503 Application with its own marks. (Opp. Br. at 12.) The legal standard is clear: the Morehouse defense precludes an opposition where an opposer failed to object to use of a mark that is substantially similar to the application opposed. O-M Bread, Inc. v. U.S. Olympic Comm., 65 F.3d 933, 36 U.S.P.Q.2d (BNA) 1041 (Fed. Cir. 1995). Odom’s pilgrim boy design is irrelevant to this inquiry.

FF has never contended that simply the addition of a torso and legs to the ‘958 Registration creates a new and distinct mark. (See Opp. Br. at 13.) FF did, during prosecution, argue the following registration was not confusingly similar to the ‘958 Registration:



(Opp. Br. at OX 19.)

This design, like Odom’s design, is distinct from the ‘503 Application and ‘958 Registration. The fact that the Examining Attorney agreed this design was not confusingly

⁴ Odom’s claims that the ‘958 Registration covers “two distinctly different marks.” (Odom’s Br. at 12.) If that was true, however, the Patent and Trademark Office would not have allowed FF to amend the ‘958 Registration.

similar to the '958 Registration and did not cite this registration during examination of the '503 Application supports a finding that confusion is unlikely in this case. These facts remain undisputed; Odom's failed to take discovery and obtain any evidence to refute them.⁵

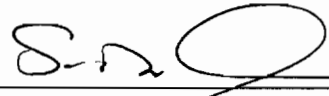
III. CONCLUSION

In conclusion, FF seeks an award of summary judgment dismissing Odom's claims for either one of two reasons: 1) no likelihood of confusion exists between FF's Farmer Boy Design and Odom's Pilgrim Boy Designs; or 2) Odom's claim is precluded by the Morehouse defense.

Respectfully submitted,

FF ACQUISITION, L.L.C.

Date: 11-20-08



Scott W. Johnston
Heather J. Kliebenstein
MERCHANT & GOULD P.C.
80 South Eighth Street, Suite 3200
Minneapolis, Minnesota 55402-2215
(612) 332-5300

⁵ Odom's contends that FF failed to assert any prejudice relating to the Morehouse defense. Odom's misstates the law, the issue is whether registration poses injury to Odom's as "the opposer cannot be further injured because there already exists an injurious registration." O-M Bread, Inc. v. U.S. Olympic Comm'n, 65 F.3d 933, 36 U.S.P.Q.2d (BNA) 1041, 1045 (Fed. Cir. 1995).

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing APPLICANT'S REPLY
MEMORANDUM IN SUPPORT OF ITS MOTION FOR SUMMARY JUDGMENT was served
upon the following attorney of record for Opposer by First Class Mail, postage prepaid, this 20th
day of November, 2008:

Marsha G. Gentner
Jacobson Holman PLLC
400 Seventh Street, N.W.
Washington, D.C. 20004



Abigail Ries

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Odom's Tennessee Pride Sausage, Inc.,)	
)	Opposition No. 91182173
Opposer,)	
)	Mark: Boy Design
v.)	
)	Serial No.: 77/148,503
FF Acquisition, L.L.C.,)	
)	Filing Date: April 4, 2007
Applicant.)	
)	Published: October 2, 2007

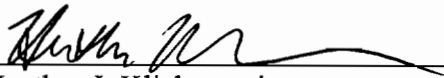
DECLARATION OF HEATHER J. KLIEBENSTEIN IN SUPPORT OF REPLY
MEMORANDUM IN SUPPORT OF APPLICANT'S MOTION FOR SUMMARY
JUDGMENT

1. I am counsel of record for Applicant FF Acquisition, L.L.C. in the captioned matter, and I make this declaration in support of Applicant's Motion for Summary Judgment.

2. To date, neither Applicant FF Acquisition, L.L.C. or Opposer Odom's Tennessee Pride Sausage, Inc., have served discovery on the other party.

The undersigned being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements and the like may jeopardize the validity of the application or document or any registration resulting therefrom, declares that all statements made of his/her own knowledge are true; and all statements made on information and belief are believed to be true.

Date: 11-20-08

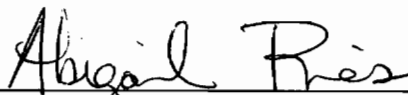


Heather J. Kliebenstein

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing DECLARATION OF HEATHER J. KLIEBENSTEIN IN SUPPORT OF APPLICANT'S MOTION FOR SUMMARY JUDGMENT was served upon the following attorney of record for Opposer by First Class Mail, postage prepaid, this 20th day of November, 2008:

Marsha G. Gentner
Jacobson Holman PLLC
400 Seventh Street, N.W.
Washington, D.C. 20004



Abigail Ries